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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,206	07/08/2003	Bernd Luhmann	101769- /tesa 469.5-KGB	8033

27384 7590 05/19/2005

NORRIS, MCLAUGHLIN & MARCUS, PA  
875 THIRD STREET  
18TH FLOOR  
NEW YORK, NY 10022

EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/615,206

Applicant(s)

LUHMANN ET AL.

Examiner

Nasser Ahmad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Rejections Maintained***

1. claims 1-4, 7 and 9-12 rejected under 35 USC 102(e) as being anticipated by Kreckel'581 or '402 for reasons of record in the last Office Action, paragraph-3, mailed on June 30, 2004.
2. claims 1-12 rejected under 35 USC 103(a) as being unpatentable over Kreckel'581 or '402 for reasons of record in the last Office Action, paragraph-5.

### ***Response to Arguments***

3. Applicant's arguments filed February 10, 2005 have been fully considered but they are not persuasive.

Applicant argues that the Office Action does not explain as to how Kreckel's hook (52) satisfies the claim requirement "fastening means". This is not found to be convincing because Kreckel's hook is a fastener as it fastens an object to the plate. Further, in the alternative, in claim 1, the phrase "if appropriate" can be interpreted to be "optional" and then it would not be deemed to be of positive limitation.

The above grounds of explanation apply *a fortiori* to the argument regarding the obviousness rejection.

Thus, in the absence of any evidence to the contrary, it remains the examiner's portion that the claimed invention is anticipated or rendered obvious as discussed above.

4. Further, the following are new grounds of rejections.

***Double Patenting***

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 1-12 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-35 of prior U.S. Patent No. 6,335,068. This is a double patenting rejection.

Both the Patent'068 and the instant application are directed to a releasable, self-adhesive device comprising a plate having spacers arranged on the rear surface and engagement elements for fastening purposes, that the rear surface has a double-sided adhesive strip adhered thereto with a grip portion protruding from the plate and a method of using the plate.

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7. Claims 1-12 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13 of prior U.S. Patent No. 5,928,747. This is a double patenting rejection.

Both the instant application and the Patent'747 are directed to the redetachable self-adhesive device having the same structure and it method of use as claimed.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,136,397. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and the Patent'397 are directed to the redetachable, self-adhesive device. However, Patent'397 fails to recite that the device has spacers provided on its rear surface. It would have been obvious to one having ordinary skill in the art to provide Patent'397's device with spacers, as

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claimed, for facilitating holding the adhesive strip in-place as shown in figure-4 of said Patent'397.

10. Claims 1012 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 61-50 of U.S. Patent No. 6,737,135. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and the Patent'135 are directed to the same structure of the redetachable self-adhesive device. However, Patent'135 fails to recite that the device has spacers on its rear surface. It would have been obvious to one having ordinary skill in the art to provide Patent'135 with spacers, as claimed, for facilitating holding the adhesive strip in-place as shown in figure-4 of said Patent'135.

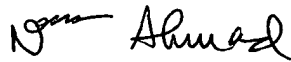
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nasser Ahmad  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
May 15, 2005.